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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/147,052	04/05/1999	SHUJI SAITOH	981167	1182

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EXAMINER

HINES, JANA A

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/147,052

Applicant(s)

SAITOH ET AL.

Examiner

Ja-Na Hines

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1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 25, 26, 32, 33, 41, 43, 44, 45, 46 is/are pending in the application.  
4a) Of the above claim(s) 45 and 46 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 25, 26, 32, 33, 41, 43 and 44 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Amendment Entry***

1. The amendment filed January 10, 2005 has been entered. Claims 25-26 and 32-33 have been amended. Claims 1-24, 27-31, 34-38 and 42 have been cancelled. Claims 45-46 have been withdrawn. Claims 25-26, 32-33, 39-41 and 43-44 are under consideration in this office action.

### ***Response to Arguments***

2. Applicant's arguments filed January 10, 2005 have been fully considered but they are not persuasive.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The rejection of claims 25-26, 32-33 and 43-44 under 35 U.S.C. 103(a) as being unpatentable over Saito et al., (WO 94/23019) and Yoshida et al., (Virology 1994 Vol. 200) and further in view of Nazerian et al. (EP 520,753) is maintained for reasons already of record. The rejection was on the grounds that it would have been prima facie obvious at the time of applicants' invention to incorporate well known sequences, useful in the same field of art, that create the same immunity and extracellular secretion as taught by Nazerian et al., into a recombinant Avipox virus or vaccine as taught by Saito et al., (WO 94/23019) and Yoshida et al., (Virology 1994 Vol. 200) since no more than routine skill would have been required to

combine an antigenic fusion protein that causes an antibody-antigen reaction which is known to be used with viruses and vaccines and a signal polypeptide derived Herpes virus gB protein which is known to be useful in directing polypeptides.

Applicants argue that the combination enables the Avipox virus or vaccine to be extremely effective in *in vivo* vaccination and that this represents unexpected results over the combined references. However, in response to applicant's argument that the references fail to show the feature of being extremely effective in *in vivo* vaccination, it is noted that the features upon which applicant relies, i.e., the ability of the virus or vaccine to be extremely effective in *in vivo* vaccination is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Moreover, the recitation of the claimed effectiveness of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use of being extremely effective in *in vivo* vaccination, then it meets the claim. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In this case, the references teach Avipox viruses and vaccines having the same components, and there is no structural difference between the prior art structure and that instantly claimed.

With respect to applicants' arguments about unexpected results, any differences between the claimed invention and the prior art may be expected to result in some differences in properties. The issue is whether the properties differ to such an extent that the difference is really

unexpected. *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The evidence must show unexpected results and not merely that the result is better than expected. In *Ex parte The NutraSweet Co.*, 19 USPQ2d 1586 (Bd. Pat. App. & Inter. 1991) applicants needed to further show that the results were greater than those which would have been expected from the prior art to an unobvious extent, and that the results are of a significant, practical advantage. *Ex parte The NutraSweet Co.*, 19 USPQ2d 1586 (Bd. Pat. App. & Inter. 1991) (Evidence showing greater than additive sweetness resulting from the claimed mixture of saccharin and L-aspartyl-L-phenylalanine was not sufficient to outweigh the evidence of obviousness because the teachings of the prior art lead to a general expectation of greater than additive sweetening effects when using mixtures of synthetic sweeteners.). Similarly, applicants' declaration states that the results were better than those of Saito et al., not that the results were unexpected. Thus, applicants' arguments are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art would have clearly been motivated to use the fused polypeptide comprising a signal polypeptide and exchange the signal polypeptide with that of Nazerian et al., because Nazerian et al., teach many beneficial effects such as the construction

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of recombinant vaccines that contain only those desired extracellularly secreted viral genes or gene products that induce immunity without exposing the animal to genes that may induce pathological disorders. Moreover, one having ordinary skill in the art would have been motivated to make such a change as a mere alternative and functionally equivalent polypeptide since only the expected results are taught. The use of antigenic isolated extracellularly secreted proteins is well known in the art along with the use of alternative signal polypeptides which are desirable to those of ordinary skill in the art based on the fact that herpes virus gB-1 gene and protein elicit neutralizing antibodies that fully protect chickens against virulent strains of MDV and it is a good candidate for an MDV vaccine as being clearly taught by Saito et al., (WO 94/23019), Yoshida et al., (Virology 1994 Vol. 200) and further in view of Nazerian et al. (EP 520,753). Therefore, applicants' arguments are not persuasive.

### *New Grounds of Rejection*

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 25-26, 32-33, 41 and 43-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Acronyms like gB must be spelled out when used for the first time in a chain of claims.

***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

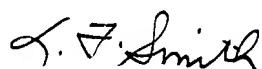
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ja-Na Hines whose telephone number is 571-272-0859. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on 571-272-0864. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ja-Na Hines   
March 28, 2005

  
**LYNETTE R. F. SMITH**  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600